

BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL TO THE BOARD OF APPEALS

In re Application of: Steven R. Placek)

Date: March 14, 2006)

Serial N°: 10/806,859)

Group Art Unit: 3617)

Filed: 03/23/2004)

Examiner: Swinehart, Edwin L.)

For: **Adjustable Boat Platform Insert**)

RECEIVED

2006 MAR 21 PM 3:00

BOARD OF APPEALS
AND INTERFERENCES

CERTIFICATE OF SERVICE

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, P.O. Box 1450, Alexandria, VA 22313-1450

Name: Terry Lakos

Date: 3/15/06

REPLY

This is a reply to the Answer received on 07/01/2005.

In appear, as previously described, the Examiner has made a combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight. This is insufficient to present a prima facie case of obviousness. In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992) There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 30 USPQ 2d 1377, 1379-80 (Fed. Cir. 1994).

RECEIVED

MAR 23 2006

GROUP 3600

When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination. In re Ichihashi, Civ. App. No. 93-1172, slip op. at 2-3 (Fed. Cir. Sep. 9, 1993) (unpublished)

In the absence of some evidence of the level of ordinary skill, including evidence tending to show what one of such ordinary skill would be motivated to accomplish in view of the cited prior art, the board may not rest a prima facie case only on its own unsupported assertions. Swede Industries v. Zebco Corp., Civ. App. No. 93-1403, slip op. at 4-5 (Fed. Cir. April 12, 1994) (unpublished)

It is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. 103, in addition to any other art, relevant or not, is also inappropriate. Additionally, there is no indication as to the motivation for combining those known element that may appear in the present invention.

Accordingly, the reversal of the Examiner by the honorable Board of Appeals is respectfully solicited.

Respectfully submitted,

John D. Gugliotta, PE, Esq.
Registration No. 36,538
Attorney for Appellant

Patent, Copyright & Trademark Law Group, LLC
USPTO Customer No. 33055
202 Delaware Building
137 South Main Street
Akron, OH 44308
(330) 253-5678
Facsimile (330) 253-6658

RECEIVED

MAR 23 2006

GROUP 3600